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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,956	11/03/2003	Michael A. McLeod	COS-926 (APIP-1125US)	5094

7590

02/07/2005

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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,956

Applicant(s)

MCLEOD ET AL.

Examiner

Mathieu D. Vargot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 37-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-36, drawn to a method of casting a film and cast film, classified in class 264, subclass 216.
- II. Claims 37-42, drawn to a system for casting a film, classified in class 425, subclass 377.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used in other methods to cast other than sPP films—ie, the apparatus can be used to make cellulose and PET films as well as congealable foodstuffs which are extruded onto a casting roll.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Alexander on December 20, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 37-42 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. Claims 12, 31-33, 35 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 calls for adding a processing aid, while claim 12 sets forth that the concentration of the aid can be 0 parts per million, which would indicate that no processing aid need be present. It is also not clear how claim 31 further limits claim 30. Claims 35 and 36 call for a blend and are dependent on claims reciting an sPP film.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7, 11, 12, 15, 23 and 25-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Shamshoun et al (see col. 2, lines 50-64; col. 4, lines 29-54).

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The applied reference discloses the instant method of casting a film comprising syndiotactic polypropylene (sPP—see examples 1 and 2 in Table 3) onto a cast/chill roller with the instant line speed. See column 4, lines 29-32 for a disclosure of casting a film of .08 mm (3.15 mil) onto a chill roll at 15.6 deg C (60 deg F) using a line speed of 30.5 m/min (100 ft/min). Table 3 lists properties such as haze (instant claim 23), 45 degree gloss (claim 25) and % elongation being less than 600 % (claim 26).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 8-10, 13, 14, 16-22, 24 and 34-36 are rejected under 35 U.S.C.

103(a) as being unpatentable over Shamshoum et al.

The applied reference discloses the basic claimed method of casting a film and film as set forth in paragraph 3, supra, Shamshoum et al essentially failing to explicitly disclose the instant casting and cast roll temperature, peak melt temperature of the sPP, exact concentration of the processing aid, the coefficient of friction of the film and the maximum tensile strength of the film being at least 4200 lb/in². It is submitted that these parameters are all well within the skill level of the art and would have been obvious variations on the process and film parameters actually taught in the applied reference. For instance, the casting temperature in Shamshoum et al would be less than the 250 deg C (482 F) temperature of the screw (see col. 4, line 31), and the temperatures of instant claims 4-6 (T= 430-300 F) would have been obvious temperatures with which to

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cast the melt to avoid any degradation of the resin. The applied reference discloses a cast roll temperature of 60 deg F and the instant temperatures slightly higher than that (ie, claims 8 and 9, $T = 90-120$ F) would have been obvious thereover dependent on how quickly one desired to cool the melt. Table 3 shows maximum tensile strengths of around 3000 lb/in² and the instant recitation of 4200 lb/in² or more would have been an obvious modification thereto dependent on the amount of orientation/stretch imparted to the film during the casting.

5.The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DeLisio et al discloses sPP films extruded at speeds of 300 ft/min (see col. 5, line 43). Hanyu et al teaches extruding films of iPP and sPP blends, and is considered to be cumulative with respect to Shamshoum et al in this regard.

6.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
February 3, 2005


Mathieu D. Vargot
Primary Examiner
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2/3/05